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MAY 9 2001
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BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Paper No. 17

Application Number: 09/121,725
Filing Date: July 24, 1998
Appellant(s): VOISIN, ERNEST A.

Thomas S. Keaty
For Appellant

EXAMINER'S ANSWER

This is in response to appellant's brief on appeal filed April 13, 2001.

(1) Real Party in Interest

A statement identifying the real party in interest is contained in the brief.

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(2) *Related Appeals and Interferences*

A statement identifying the related appeals and interferences which will directly affect or be directly affected by or have a bearing on the decision in the pending appeal is contained in the brief.

(3) : *Status of Claims*

The statement of the status of the claims contained in the brief is correct.

(4) *Status of Amendments After Final*

The appellant's statement of the status of amendments after final rejection contained in the brief is correct.

(5) *Summary of Invention*

: The summary of invention contained in the brief is correct.

(6) *Issues*

The appellant's statement of the issues in the brief is correct.

(7) *Grouping of Claims*

The rejection of claims 3-4 and 6-7 stand or fall together because appellant's brief does not include a statement that this grouping of claims does not stand or fall

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together and reasons in support thereof, other than a mere recitation of the claims themselves. See 37 CFR 1.192(c)(7).

(8) Claims Appealed

A substantially correct copy of appealed claim 3 appears on page 15 of the Appendix to the appellant's brief. The minor errors are as follows: line 1 should read "while **said** shellfish is".

A substantially correct copy of appealed claim 6 appears on page 15 of the Appendix to the appellant's brief. The minor errors are as follows: line 2 should read "exposing **said** raw oysters".

These additions were made by the Examiner's Amendment, paper no. 5.

(9) Prior Art of Record

JP 4356156A

Miura et al

12-1992

Cheftel, J.C. "Effects of high hydrostatic pressure on food constituents: an overview"

High Pressure and Biotechnology, Vol. 224, 1992, pp. 195-209

(10) Grounds of Rejection

The following ground(s) of rejection are applicable to the appealed claims:

Claims 6-7 are rejected under 35 U.S.C. 102(b) as being anticipated by

JP 4356156A.

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JP 4356156A teach a method of treating shellfish comprising exposing raw oysters (paragraph 0005) contained in plastic bags filled with sea-water (paragraph 0010) to hydrostatic pressures of 14,615-44,087 psi for 0.5-10 minutes at ambient temperatures (paragraph 0006). Although JP 4356156A do not recite any effect upon pathogenic *Vibriones* bacteria, the method steps utilized in the reference are the same as those instantly claimed, and thus one of ordinary skill in the art would have expected the same results. The claimed characteristic of eliminating pathogenic *Vibriones* bacteria is considered an inherent property and result of the referenced method, and not unique to the instant invention, absent any clear and convincing evidence or arguments to the contrary. Further, it was known that high pressure treatment of seafood destroyed pathogenic organisms such *Vibrio*, as evidenced by Cheftel [Effects of high hydrostatic pressure on food constituents: an overview] (page 204, heading 1.2).

Claims 3-4 are rejected under 35 U.S.C. 103(a) as being unpatentable over JP 4356156A.

JP 4356156A teach a method of treating shellfish by providing a pressure vessel (paragraph 0010) and exposing raw oysters (paragraph 0005) contained in plastic bags filled with sea-water (paragraph 0010) to hydrostatic pressures of 14,615-44,087 psi for 0.5-10 minutes at ambient temperatures (paragraph 0006). Although JP 4356156A do not recite any effect upon pathogenic *Vibriones* bacteria, the method steps utilized in the reference are the same as those instantly claimed, and thus the same results would also have been expected. The claimed characteristic of eliminating pathogenic *Vibriones* bacteria is considered an inherent property and result of the referenced

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method, and not unique to the instant invention, absent any clear and convincing evidence or arguments to the contrary. Although not specifically recited, it would have been obvious to one of ordinary skill in the art to refrigerate the pressure treated oysters of JP 4356156A since cooling to refrigeration temperatures was a commonly used method of preserving raw food products.

(11) *Response to Argument*

Appellant incorrectly cites the treatment time of JP 4356156A as 0.5-5 minutes. Appellant's attention is drawn to paragraph 0006 of the translated reference which includes a treatment time of up to 10 minutes.

Appellants argue that since the European Patent Office listed the JP 4356156A reference as an "A" reference, it did not defeat the novelty of the appellant's method. It is noted that the European Patent Office is not the same entity as the USPTO and does not operate under the same rules and laws. Regardless, this "A" listing was probably due to the fact that the translated abstract for JP 4356156A incorrectly listed the pressure range as "1-44 atmospheres" (646 psi) and that the true pressure range was not apparent until the Examiner had the reference fully translated.

Regarding the three declarations obtained by the appellant, none of the three mention or discuss the JP 4356156A reference but merely state that the respective declarants were not personally aware of this process. This would not be sufficient to overcome the rejection, as the reference was publicly available, and therefore properly applicable as prior art against the claims.

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Appellant argues against the inherent microbiological effects of the method of JP 4356156A. Although JP 4356156A does not recite any effect upon pathogenic Vibriones bacteria, the method steps utilized in the reference are the same as those instantly claimed, and thus the same results would also have been expected. The claimed characteristic of eliminating pathogenic Vibriones bacteria is considered an inherent property and result of the referenced method, and not unique to the instant invention, absent any clear and convincing evidence or arguments to the contrary on the record. Further, it was known that high pressure treatment of seafood destroyed pathogenic microorganisms such as Vibrio, as evidenced by Cheftel (page 204, heading 1.2).

Regarding inherency, paragraph 2112 of the MPEP states:

"The claiming of a new use, new function or unknown property which is inherently present in the prior art does not necessarily make the claim patentable. In re Best, 562 F.2d 1252, 1254, 195 USPQ 430, 433 (CCPA 1977). See also MPEP § 2112.01 with regard to inherency and product-by-process claims and MPEP § 2141.02 with regard to inherency and rejections under 35 U.S.C. 103."

Appellant argues that since this application was subject to a restriction requirement prior to initial examination, that the two methods are unrelated. While the two methods in question (shucking of shellfish using high pressure and pasteurization of shellfish using high pressure), were not examined in the same application, this does not constitute a judgement on patentability between the instant claims and JP 4356156A. The restriction in question was based on the methods having different effects in addition

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to different pressure ranges and the use of a flexible band. Regardless, the restriction was based solely on the appellant's claims and is not relevant to the present rejection over JP 4356156A. As mentioned above, the method steps utilized in JP 4356156A are the same as those instantly claimed, and thus the same results would have been expected, particularly in view of the pasteurization teachings of Cheftel showing the general knowledge in the art at the time the invention was made.

Appellant states that Cheftel "was not cited in the rejection of the claims and reference to this book in addition to the Japanese reference is improper in establishing anticipation under Section 102". Attention is drawn to paragraph 2 of the Final Rejection (paper no. 13) which cites Cheftel as an evidentiary reference regarding the pressure treatment of seafood to eliminate *Vibrio* (page 204, heading 1.2). This reference was cited in response to appellant's arguments, and thus is properly included herein. It does not add to the teachings of JP 4356156A, such as in a 103 rejection, but rather merely provides evidence of the teaching of the JP 4356156A patent.

Attention is drawn to paragraph 2131.01 which states:

"To serve as an anticipation when the reference is silent about the asserted inherent characteristic, such gap in the reference may be filled with recourse to extrinsic evidence. Such evidence must make clear that the missing descriptive matter is necessarily present in the thing described in the reference, and that it would be so recognized by persons of ordinary skill."
Continental Can Co. USA v. Monsanto Co., 948 F.2d 1264, 1268, 20 USPQ2d 1746, 1749 (Fed. Cir. 1991) "

With regard to the rejection under 35 USC 103(a), in response to appellant's argument that the examiner's conclusion of obviousness is based upon improper

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hindsight reasoning, it must be recognized that any judgment on obviousness is in a sense necessarily a reconstruction based upon hindsight reasoning. But so long as it takes into account only knowledge which was within the level of ordinary skill at the time the claimed invention was made, and does not include knowledge gleaned only from the applicant's disclosure, such a reconstruction is proper. See *In re McLaughlin*, 443 F.2d 1392, 170 USPQ 209 (CCPA 1971). In this case the same process steps were taught by JP 4356156A which would have inherently produced the same effects as appellant's method. Regardless, it was known that high pressure treatment of seafood destroyed pathogenic microorganisms such as *Vibrio*, as evidenced by Cheftel (page 204, heading 1.2).


Appellant argues on pages 10-11 against the "obviousness" of eliminating pathogenic bacteria in the method of JP 4356156A. Attention is drawn to 103(a) rejections of paper no. 13 which state that eliminating pathogenic bacteria was an inherent property and result, and that the "obviousness" of the rejection was directed to the refrigeration of the raw oysters of JP 4356156A after pressure treatment since this was a commonly used method of preserving raw food products.

Appellant argues that the method steps of claims 3-4 have been ignored. These claims were not ignored, and the limitations therein were taught by the reference as discussed in the 103 rejection of paper no. 13. Attention is again drawn to paragraph 0010 of JP 4356156A which taught a pressure vessel, placing oysters in the pressure vessel, a pressure transmitting liquid in the form of sea water, and treating with a pressure of 3000 atmospheres (~44,087 psi) for a time period of 3 minutes.

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For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,


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May 2, 2001


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